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#6  
DAGS  
9-21-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Shibasaki et al. )  
S.N.: 10/088,425 ) Examiner: J. Murphy  
Filed: March 15, 2002 ) Art Unit: 1626  
For: PROCESSES FOR THE PREP-) ARATION OF 4(5)-AMINO-) 5(4)-CARBOXAMIDOIMI-) DAZOLES AND INTERME-) DIATES THEREOF )

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I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Patents and Trademarks, Washington, DC 20231

Lia H. Costello

Lia H. Costello, Legal Assistant

Box Non-Fee Amendment  
Assistant Commissioner for  
Patents and Trademarks

RESPONSE

Dear Sir:

Before addressing the restriction requirement, Applicants request clarification as to which priority document is not in the U.S. file. According to PCT//IB/304 form, all 3 priority documents were submitted to the International Bureau and all three should be available to the

designated states, including the U.S. Please confirm which is missing and whether or not the Examiner is going to request it from the IB, or will he accept a copy from Applicants, or whether he requires a certified copy from the Japanese Patent Office. Considering the PCT form, it seems unnecessary to submit a certified copy and it would seem that the proper procedure would be for the Examiner to request a copy from the IB.

The Office Action Summary, mailed August 30, 2002, having a shortened statutory period for response set to expire September 30, 2002, requires restriction to one of the following alleged patentably distinct groups under 35 U.S.C. §121 and §372:

- I. Claims 1-5, 8 and 15-18, drawn to methods of making;
- II. Claims 6, 15 and 17-18, drawn to methods of making;
- III. Claims 7-10, 15 and 17-18, drawn to methods of making;
- IV. Claims 11, 12, 15 and 17-18, drawn to methods of making;
- V. Claims 13 and 19-21, drawn to compounds; and
- VI. Claims 14-18, drawn to methods of making.

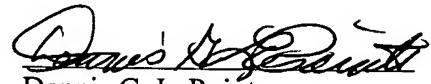
**Applicant, in accordance with the election requirement, elects Group I.**

There is still a very close relationship between the Groups. As the Examiner is aware, Section 121 requires the Examiner to find that the inventions be independent and distinct. Also see, Torok v. Watson, Com'r Pats., 122 F. Supp. 788, 103 U.S.P.Q. 78 (DC 1954). In addition, the statutory basis of restriction practice under Section 121, provides that if two or more independent and distinct inventions are claimed in one patent application, the Examiner may require the application be restricted to one invention. This authority is discretionary, not

mandatory. Accordingly, Applicants respectfully request that such discretionary authority not be invoked and the restriction requirement be withdrawn.

Very respectfully,

Dated: 9/19/02

  
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1626

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Practitioner's Docket No. 1576.99RECEIVED  
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SEP 24 2002

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Hiroaki SHIBASAKI et al.

Application No.: 10/088,425

Group No.: 1626

Filed: 03/15/2002

Examiner: Jennifer C. Murphy

For: PROCESSES FOR THE PREPARATION OF 4(5)-AMINO-5(4)-CARBOXAMIDOIMIDAZOLES  
AND INTERMEDIATES THEREOFCommissioner for Patents  
Washington, D.C. 20231

## AMENDMENT TRANSMITTAL

- Transmitted herewith is an amendment for this application.

## STATUS

- Applicant is other than a small entity.

## EXTENSION OF TERM

- The proceedings herein are for a patent application and the provisions of 37 C.F.R. 1.136 apply. Applicant believes that no extension of term is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition for extension of time.

## CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\*

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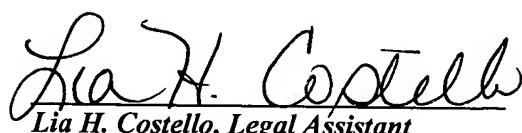
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## TRANSMISSION

facsimile transmitted to the Patent and Trademark Office, (703) \_\_\_\_\_

Date: September 20, 2002
  
 Lia H. Costello, Legal Assistant

\* Only the date of filing (' 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under ' 1.8 continues to be taken into account in determining timeliness. See ' 1.703(f). Consider "Express Mail Post Office to Addressee" (' 1.10) or facsimile transmission (' 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

## FEE FOR CLAIMS

4. The fee for claims (37 C.F.R. 1.16(b)-(d)) has been calculated as shown below:

(Col. 1) CLAIMS REMAINING AFTER AMENDMENT	(Col. 2) HIGHEST NO. PREVIOUSLY PAID FOR	(Col. 3) PRESENT EXTRA	OTHER THAN A SMALL ENTITY		
			RATE		ADDIT. FEE
TOTAL	10 -	21 =	0 x \$ 18.00	=	\$ 0.00
INDEP.	3 -	9 =	0 x \$ 84.00	=	\$ 0.00
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM			+ \$ 0.00	=	\$ 0.00
			TOTAL ADDIT. FEE		\$ 0.00

No additional fee for claims is required.

Date: 9/19/02

Reg. No.: 40,693  
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 Customer No.: 24040

Signature of Practitioner  
 Dennis G. LaPointe  
 Mason & Associates, P.A.  
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SEP 12 2002  
PRACTICE GROUP

Practitioner's Docket No. 1576.99

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Application No.: 10/088,425

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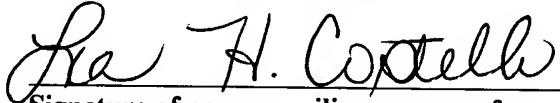
Date of Deposit 09/20/2002

I hereby state that the following *attached* paper or fee

- Amendment Transmittal
- Response to Office Action mailed August 30, 2002
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- Post card

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10, on the date indicated above and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

Lia H. Costello, Legal Assistant

  
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